

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: *Laurie H. Glimcher and
John Douhan III*

Serial No.: 09/879,312

Filed: June 12, 2001

For: HUMAN C-MAF COMPOSITIONS AND
METHODS OF USE THEREOF

Attorney Docket No.: HUI-027CPDV1

Group Art Unit: 1632

Examiner: Wortach, Joseph T.

Commissioner for Patents
Washington, D.C. 20231


Certificate of Facsimile Transmission

I hereby certify that this correspondence is being facsimile transmitted to the Commissioner for Patents, Washington, D.C. 20231 on the date set forth below.

April 3, 2003

Date of Signature

By:


Megan E. Williams, Esq.
Attorney for Applicants
Registration No: 43,270

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is an Amendment and Response to the Restriction Requirement dated October 3, 2002 (Paper No. 5). A request for the appropriate extension of time is being submitted herewith

The Examiner has required restriction to one of the following groups:

Group I: Claims 29, 30, 32, 33, 51-54, drawn to a method to identify a compound that modulates the activity of human c-Maf protein comprising evaluating the binding of a human c-Maf DNA molecule;

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- Group II: Claims 29, 30, 32, 33, 51-54, drawn to a method to identify a compound that modulates the activity of human c-Maf protein comprising evaluating the activity of a human c-Maf protein; and
- Group III: Claims 55 and 56, drawn to a method to identify a protein which interacts with human c-Maf.

Applicants note that claims 29-60 are pending in the application.

Applicants hereby elect **group II with traverse**. Applicants traverse the restriction requirement to the extent that groups I and II should be reformed as a single group containing claims 29-54 and 57-60 (referred to hereinafter as "newly formed Group I"). Applicants grounds for traversal are set forth below.

It is respectfully submitted that Applicant has presented an allowable generic claim, claim 29, which is generic to the claims set forth in groups I and II proposed by the Examiner and claims 57-60. Claim 29 is directed to a method for identifying a compound that modulates the activity of a human c-Maf protein, comprising, providing an indicator composition that comprises a human c-Maf protein; contacting the indicator composition with a test compound; and determining the effect of the test compound on the activity of the human c-Maf protein in the indicator composition to thereby identify a compound that modulates the activity of a human c-Maf protein. Claim 29 embraces measuring the activity of a c-Maf protein whether by measuring the ability of the protein to bind to DNA (claim 30), evaluating expression of a reporter gene (claim 31), or evaluating the level of cytokine production (claim 57).

It is Applicants' position that given the presence of claim 29, which is generic to groups I and II proposed by the Examiner and claims 57-60 a restriction under 35 U.S.C. §121 is improper. In view of the above traversal, Applicants hereby elect **newly formed Group I**, claims 29-54 and 57-60.

It is Applicants' position that while a species election maybe proper among claims 30, 31 and 57 for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, and election under 35 U.S.C. § 121 is improper since the claims are linked by an allowable generic linking claim, claim 29. If a species election is required, Applicants further provisionally elect evaluating expression of a reporter gene for search purposes only. It is Applicants understanding that the search will be extended to the remaining species upon a finding of allowability.

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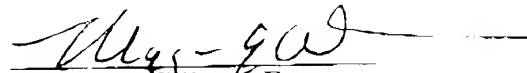
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CONCLUSION

If the Examiner believes that a telephone conversation with Applicants' Attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at (617) 227-7400.

Respectfully submitted,

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Date: April 3, 2003